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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/789,022	02/27/2004	Hisanori Mori	0666.2190000	7151
26111	7590	09/09/2005	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX PLLC 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			VASUDEVA, AJAY	
			ART UNIT	PAPER NUMBER
			3617	

DATE MAILED: 09/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

10/789,022

Applicant(s)

MORI ET AL.

Examiner

Ajay Vasudeva

Art Unit

3617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 3 and 18-22 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 10-17 and 23-25 is/are allowed.
- 6) ☒ Claim(s) 1 and 7-9 is/are rejected.
- 7) ☒ Claim(s) 2 and 4-6 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 3617

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Species I (figures 1 and 2) – as represented by claims 1, 2, 4-17 and 23-25 -- in the reply filed on 6/16/2004 is acknowledged.

Claims 3, and 18-22 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to the nonelected Species, there being no allowable generic or linking claim.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by EP 1013544 A2 ('544).

EP ('544) shows a power generating and propelling system of a vessel (figure 9) having an internal combustion engine [25], a power transmission device [30, 37], an electric power generating equipment [28] provided between the internal combustion engine and the power transmission device, and an electric motor [31] disposed at an area of the power transmission device.

Art Unit: 3617

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 1013544 A2 ('544) in view of Wilson (US 2,466,525 A).

EP ('544) shows a vessel having an engine, as above. However, EP ('544) fails to show a cooling system for the engine.

Wilson shows a cooling system for cooling an engine, providing both an open circuit and a closed circuit circulation of cooling water.

It would have been obvious for one skilled in the art at the time of the invention to incorporate a cooling system in the vessel of EP ('544), as taught by Wilson. Having such a cooling system would have prevented an overheating of the engine, thereby improving the operational efficiency of the engine.

Regarding the limitation "cooling water ... is passed near the electric motor" (emphasis added), it is noted that the term "near" is merely a relative term. Because the electric motor of EP ('544) is located closer to the engine with respect to a more distant object – such as the bow of the vessel –, the cooling water circulating through the engine is considered to be passing near the motor when considered with respect to the distant bow of the boat.

Art Unit: 3617

Allowable Subject Matter

6. Claims 2 and 4-6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
7. Claims 10-17 and 23-25 are allowed.

Conclusion

8. The prior art made of record, but not yet relied upon, is considered pertinent to applicant's disclosure.

The prior art references cited in the attached PTO Form 892 each show a vessel having at least one internal combustion engine, a power transmission device, a generator/alternator, and an electric motor.

Examiner's Observations: Applicant is advised to consider the following possible interpretations of certain claim limitation that may be used in the next Office action(s):

The "power transmission device" recited in claim 1 can be broadly interpreted to mean any such device that is capable of transmitting either electrical, hydraulic or mechanical power.

Further, the claim(s) do not specifically require such "power transmission device" to transmit power to the propulsion mechanism of the vessel. As such, the transmission device can be broadly interpreted to mean any such device that transmits power to any type of equipment – such as an auxiliary equipment on the vessel --, and not necessarily limited to transmitting power to the propulsion mechanism.


Art Unit: 3617

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ajay Vasudeva whose telephone number is (571) 272-6689. The examiner can normally be reached on Monday-Friday 12:00 -- 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, S. Joe Morano can be reached on (571) 272-6684. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ajay Vasudeva
Examiner
Art Unit 3617


AJAY VASUDEVA
PATENT EXAMINER 9/5/05